

Filed August 28, 2020

Filed on behalf of **ILLUMINA, Inc.**

By: Kerry S. Taylor

Nathanael R. Luman

Michael L. Fuller

KNOBBE, MARTENS, OLSON & BEAR, LLP

2040 Main Street, 14th Floor

Irvine, CA 92614

Tel.: (858) 707-4000 Fax: (858) 707-4001

E-mail: BoxIllumina@knobbe.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ILLUMINA, INC.,
Petitioner,

v.

TRUSTEES OF COLUMBIA UNIVERSITY
IN THE CITY OF NEW YORK,
Patent Owner.

IPR2020-01177
Patent 10,435,742

**UNOPPOSED MOTION FOR WILLIAM R. ZIMMERMAN TO APPEAR
PRO HAC VICE ON BEHALF OF PETITIONER ILLUMINA, INC.**

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to the Board's July 16, 2020 Notice of Filing Date Accorded (Paper 3) and 37 C.F.R. §§ 42.10(c) and 42.22, Petitioner Illumina, Inc. ("Illumina") hereby moves for an Order allowing William R. Zimmerman of Knobbe, Martens, Olson & Bear, LLP to appear *pro hac vice* on behalf of Illumina in the above-captioned case. Petitioner Illumina has conferred with counsel for Patent Owner The Trustees of Columbia University in the City of New York ("Columbia"), and Columbia does not oppose Illumina's motion to allow Mr. Zimmerman to appear *pro hac vice* in this matter.

II. LIST OF EXHIBITS RELIED UPON FOR THIS MOTION

Illumina Exhibit 1137 - Declaration of William R. Zimmerman in Support of Motion to Appear *Pro Hac Vice* on Behalf of Petitioner Illumina, Inc.

III. REASONS THE REQUESTED RELIEF SHOULD BE GRANTED

As set forth below in the Statement of Material Facts, Illumina has made all of the showings required under 37 C.F.R. § 42.10(c) for recognizing Mr. Zimmerman *pro hac vice*. In particular, Mr. Zimmerman is an experienced litigation attorney who has represented clients in numerous patent litigation cases in various United States District Courts and the Court of Appeals for the Federal Circuit, including technically and legally complex matters such as will be present in this

proceeding. Accordingly, allowing Mr. Zimmerman to appear *pro hac vice* on behalf of Illumina is appropriate in this proceeding.

IV. STATEMENT OF MATERIAL FACTS

1. 37 C.F.R. § 42.10(c) provides that “[t]he Board may recognize counsel *pro hac vice* during a proceeding upon a showing of good cause, subject to the condition that lead counsel be a registered practitioner and to any other conditions as the Board may impose. For example, where the lead counsel is a registered practitioner, a motion to appear *pro hac vice* by counsel who is not a registered practitioner may be granted upon showing that counsel is an experienced litigating attorney and has an established familiarity with the subject matter at issue in the proceeding.”

2. Lead counsel for Illumina in this *inter partes* review proceeding is Kerry S. Taylor. Mr. Taylor is registered to practice before the United States Patent and Trademark Office and holds Registration No. 43,947.

3. As set forth in Illumina Exhibit 1137 (the “Zimmerman Declaration”), Mr. Zimmerman is an experienced litigating attorney and has an established familiarity with the subject matter at issue in this proceeding. Zimmerman Decl. ¶ 4. In particular, Mr. Zimmerman has approximately 23 years of experience as a patent litigator and has represented clients in numerous patent litigation cases in various United States District Courts and the Court of Appeals for the Federal Circuit. *Id.*

¶ 2. In addition, Mr. Zimmerman has experience in *inter partes* review proceedings, for example, IPR2013-00024, IPR2013-00128, IPR2013-00266, IPR2013-00517, IPR2013-00518, IPR2014-00549, IPR2014-00550, IPR2014-01093, IPR2015-00265, IPR2015-00268, IPR2016-00397, IPR2016-00399, IPR2016-00549, IPR2016-00553, IPR2016-00557, IPR2016-00559, IPR2016-01198, IPR2016-01201, IPR2017-02172, IPR2017-02174, IPR2018-00291, IPR2018-00318, IPR2018-00322, IPR2018-00385, IPR2018-00795, IPR2018-00797, IPR2018-01317, and IPR2019-01201. *Id.* ¶ 2.

4. Further, Mr. Zimmerman holds a Bachelor of Science degree in Chemical Engineering from the University of Notre Dame and served as a law clerk to the Honorable Alvin A. Schall, Circuit Judge of the United States Court of Appeals for the Federal Circuit. *Id.* ¶ 3. Moreover, Mr. Zimmerman is experienced with technically and legally complex matters in the field of chemistry and biotechnology. *Id.*

5. With regard to U.S. Patent No. 10,435,742 (“the ’742 patent”), the patent at issue in this proceeding, Mr. Zimmerman is familiar with the ’742 patent, and with the legal subject matter, technical subject matter, and prior art discussed in Illumina’s request for *inter partes* review of the ’742 patent. *Id.* ¶ 4. Mr. Zimmerman also is familiar with the U.S. Patents, legal subject matter, technical subject matter, and prior art discussed in the related matters of IPR2020-00988

(challenging U.S. Patent 10,407,458), IPR2020-01065 (challenging U.S. Patent 10,407,459), IPR2020-01125 (challenging U.S. Patent 10,457,984), and IPR2020-01323 (challenging U.S. Patent 10,428,380). *Id.* In view of his legal experience, technical background, and familiarity with the issues in the present matter and the related matters, Petitioner Illumina, Inc. has requested his services in the present matter and related matters of IPR2020-01065, IPR2020-01125, IPR2020-01177, and IPR2020-01323. Denial of his appearance in this case would create an undue burden on Patent Owner. *Id.*

6. Mr. Zimmerman has read and will comply with the Office Patent Trial Practice Guide and the Board’s Rules of Practice for Trials set forth in Part 42 of Title 37 of the Code of Federal Regulations. *Id.* ¶ 9. Mr. Zimmerman also agrees to be subject to the United States Patent and Trademark Office Rules of Professional Conduct set forth in 37 C.F.R. §§ 11.101 *et seq.*, and disciplinary jurisdiction under 37 C.F.R. § 11.19(a). *Id.* ¶ 10.

7. Finally, Mr. Zimmerman has attested to the remaining elements of Paragraph 2(b) of the representative “Order – Authorizing Motion *for Pro Hac Vice Admission*” in Case IPR2013-00639, Paper 7. *Id.* ¶¶ 4–11; *see* Notice of Filing Date Accorded to Petition and Time for Filing Patent Owner Preliminary Response (Paper 3) at 2.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.